REMARKS

Claims 1, 2, 4, 8, 11 and 12 have been amended.

The Examiner has rejected applicant's claims 1, 8 and 10-12 under 35 USC 103(a) as unpatentable over the Koseki, et al. patent (U. S. Patent No. 7,098,946) taken with the Satoh, et al. patent (U. S. Patent No. 5,329,163). The Examiner has rejected applicant's claims 2 and 4 also under 35 USC 103(a) as unpatentable based on the latter references taken with the Ejima, et al. reference (US Published Patent Application Publication No. 2002/0,008,765). With respect to applicant's claims, as amended, these rejections are respectfully traversed.

More particularly, applicant's independent claim 1 has been amended to better define applicant's invention. In particular, amended claim 1 recites an image pickup apparatus including a first mode for picking up an object image and a second mode for reproducing a recorded image, said apparatus comprising: a first operation member which is operable toward a first position corresponding to the first mode, and is operable toward a second position corresponding to the second mode, and further itself is automatically forced to be suppressed to a third position different from each of the first position and the second position when said first operation member is not operated by a user; a second operation member different from said first operation member; and a control unit, which effects control of said image pickup apparatus so as to make said image pickup apparatus active in accordance with the mode corresponding to the position to which said first operation member is operated to one of the first position and the second position, if said first operation member is operated when said image pickup apparatus is in a non-active state, switch over the mode of said image pickup apparatus to the mode corresponding to the position to which said first operation member is operated, if said first operation member is operated to one of the first position and the second position when said

image pickup apparatus is in an active state and the current mode of said image pickup apparatus is different from the mode corresponding to the position to which said first operation member is operated, and make said image pickup apparatus shift from the active state to the non-active state if said second operation member is operated when said image pickup apparatus is in the active state and said first operation member is positioned at the third position. Independent method claim 8 has similar features and has been similarly amended.

Additionally, independent claim 11 has been amended to recite an image pickup apparatus including a first image pickup mode for picking up an object image, a second image pickup mode for picking up an object image, a first image reproduce mode for reproducing a recorded image and a second image reproduce mode for reproducing a recorded image, said apparatus comprising: a first operation member which is operable toward a first position corresponding to the first and second image pickup mode, and is operable toward a second position corresponding to the first and second image reproduce mode, and further itself is automatically forced to be suppressed to a third position different from each of the first position and the second position when said operation member is not operated by a user; a second operation member different from said first operation member; a control unit which controls mode switching of said image pickup apparatus so as to switch over the mode thereof between the first pickup mode and the second pickup mode if said first operation member is operated to the first position when said image pickup apparatus is in one of the first image pickup mode and the second image pickup mode, switch over the mode of said image pickup apparatus to one of the first image reproducing mode and the second image reproducing mode if said first operation member is operated to the second position when said image pickup apparatus is in one of the first image pickup mode and the second image pickup mode, switch over the mode

of said image pickup apparatus between the first image reproducing mode and the second image reproducing mode if said first operation member is operated to the second position when said image pickup apparatus is in one of the first image reproducing mode and the second image reproducing mode, switch over the mode of said image pickup apparatus to one of the first image pickup mode and the second image pickup mode if said first operation member is operated to the first position when said image pickup apparatus is in one of the first image reproducing mode and the second image reproducing mode, and make said image pickup apparatus shift from the active state into the non-active state if said second operation member is operated when said image pickup apparatus is in the active state and said first operation member is positioned at the third position. Independent method claim 12 includes like features and has been similarly amended.

As can be appreciated from the above, independent claims 1 and 11 each recite an image pickup apparatus having the feature of a first operation member (e.g., 4-1 in FIG.4A) which is automatically forced to be suppressed to a third position different from each of first second positions corresponding respectively to first and second modes when the operation member is not operated by a user. Each of claims 1 and 11 have also been amended to recite that the image pickup apparatus has the additional feature of a second operation member (e.g., 4-2 in Fig.4A) different from the first operation member arranged to shift the image pickup apparatus from an active state to a non-active state in accordance with the second operation member being operated when the image pickup apparatus is in the active state and the first operation member is positioned at the third position (e.g., step S503 in FIG. 5 and S805 in FIG. 8 and the accompanying description).

The above-described features, as well as the other features, of applicant's independent

claims 1 and 11 and their corresponding method claims 8 and 12 are not taught or suggested by the cited art of record. More particularly, the Koseki, et al. patent discloses a digital camera having a ring-like R/P changeover switch button 26 (Fig.2) which is rotatably operative to switch over between a recording mode and a playback mode. The Koseki, et al. patent describes this switch as follows: "Provided on the circumference of the power switch button 25 is a ring-like R/P changeover switch button 26 which is turned to be operated. The R/P changeover switch button 26 is to switch between recording and playback. By turning it about the power switch button 25 to operate an internally located R/P switch, switching recording/playback modes is controlled." Col. 11, lines 15-22. The patent also describes the recording operation as follows: "Recording operation of the image pickup apparatus having the above described construction will now be described. First, the power switch button 25 is pressed down to introduce power and recording mode is set by the R/P changeover switch button 26. An image taking mode is then set by the mode setting buttons 30. In the present embodiment, those that can be selected and set by the input keys 20, i. e., the mode setting buttons 30 as image taking mode are : a normal image taking mode . . . an automatic wide dynamic range image taking mode . . . and a forced SL image taking mode . . .." Col. 12, lines 3-27.

Thus, in the Koseki, et al. patent, the power switch 25 must be turned on to place the camera in an active state. Then, the R/P switch can be rotated to place the camera in the recording mode (R) or the playback mode (P). Moreover, in the recording mode (R), different ones of the buttons 30 must be pushed in order to select the different types of recording modes available, i.e., the normal, automatic wide dynamic range and forced SL image taking modes.

Thus, the Koseki, et al. patent fails to teach or suggest the feature of applicant's amended claim 1 of a "control unit, which effects control of said image pickup apparatus so as

to make said image pickup apparatus active in accordance with the mode corresponding to the position to which said first operation member is operated to one of the first position and the second position, if said first operation member is operated when said image pickup apparatus is in a non-active. In the Koseki, et al. patent, if the R/P switch is rotated with the camera being in-active, i.e., the power switch 25 has not been previously pressed, the camera is not placed in an active recording mode.

The Examiner attempts to apply the Koseki, et al. patent to this feature of amended claim 1 by interpreting the inactive state to be "as when the camera power is off and just power on before the ring-like R/P is turned to be operated". However, this interpretation amounts to arguing that the inactive state of the camera includes when power is off and when power is on which is believed to be an untenable argument. Accordingly, this argument appears to be based on the Examiner's attempt to read the reference on applicant's claims and not on what can be reasonably sustainable from what the reference teaches. It is thus submitted that the above feature of amended claim 1 is not taught or suggested by the Koseki, et al. patent.

It is additionally submitted that the Koseki, et al. patent fails to teach or suggest the following feature of applicant's amended claim 11:

a first operation member which is operable toward a first position corresponding to the first and second image pickup mode, and is operable toward a second position corresponding to the first and second image reproduce mode,

It follows, therefore, that the patent cannot and does not teach or suggest the following additional features of applicant's amended claim 11:

a control unit which controls mode switching of said image pickup apparatus so as to:

switch over the mode thereof between the first pickup mode and the second pickup

mode if said first operation member is operated to the first position when said image pickup apparatus is in one of the first image pickup mode and the second image pickup mode,

switch over the mode of said image pickup apparatus to one of the first image reproducing mode and the second image reproducing mode if said first operation member is operated to the second position when said image pickup apparatus is in one of the first image pickup mode and the second image pickup mode,

switch over the mode of said image pickup apparatus between the first image reproducing mode and the second image reproducing mode if said first operation member is operated to the second position when said image pickup apparatus is in one of the first image reproducing mode and the second image reproducing mode,

switch over the mode of said image pickup apparatus to one of the first image pickup mode and the second image pickup mode if said first operation member is operated to the first position when said image pickup apparatus is in one of the first image reproducing mode and the second image reproducing mode,

In the Koseki, et al. patent, there is no discussion of the recording (R) position of the switch 26 corresponding to first and second recording modes, nor of the playback (P) position corresponding to first and second playback modes. With respect to the recording (R) position of the switch 26, it is the switches 30 which have to be used after the switch 26 operation to select different recording or image pickup modes, not the switch 26, and the reference mentions nothing about multiple recording modes being associated with the switch 26. Column 11, lines 12-22 of the patent cited by the Examiner simply do not teach or suggest this.

Moreover, there is nothing taught or suggested about switching between first and second

recording modes when a first operating member having a first position associated with these recording modes is moved to the first position with the apparatus in one of these recording modes, nor switching the apparatus to one or the other of first and second playback modes by moving the first operating member to a second position when the apparatus is in one or the other of the first and second recording modes, nor switching between first and second reproducing modes when the first operating member is moved to the second position with the apparatus is in one of these reproducing modes, nor switching the apparatus to one or the other of first and second recording modes by moving the first operating member to a first position when the apparatus is in one or the other of the first and second playback modes.

For the above reasons alone, applicant's claims 1, 8, 11, and 12, and their respective dependent claims, are believed to patentably distinguish over the Koseki, et al. patent. Moreover, the cited Satoh, et al. patent and Ejima, et al. reference were cited for features of applicant's claims unrelated to those discussed above as patentably distinguishing over the Koseki, et al. patent. The above features thus patentably distinguish the claims over all these patents.

Additionally, the Examiner has acknowledged that the Koseki, et al. patent fails to teach or suggest the following feature of applicant's claims 1 and 11: a first operation member which is . . . further itself is automatically forced to be suppressed to a third position different from each of the first position and the second position when said first operation member is not operated by a user. The Examiner has also stated that the Koseki, et al. patent also fails to teach or suggest the following canceled feature of amended claims 1 and 11: a control unit which continues the mode corresponding to the position to which said operation member is operated to one of the first position and the second position, even if said operation member is

automatically forced to the third position after said operation member is operated to one of the first position and the second position. However, the Examiner then argues that the Satoh, et al. patent teaches these features.

More particularly, the Examiner states: "In the same field of switches, Satoh teaches a switching system for performing manual or auto switching operation. According to Satoh, the switch will assume either an auto-up position AT.sub.UP or auto-down position AT.sub.DWN even when an operator's hand is removed from the knob K.sub.b to return it to its neutral position N (third position). Electric current flowing through either one of the auto-switches C.sub.A will allow the auto-condition retaining circuit A.R.C to assume auto-operation condition (Col. 1, Ln. 63-Col. 2, Ln. 25)". The Examiner then concludes as follows: "In light of the teaching of Satoh, it would have been obvious to one of ordinary skill in the art . . . to modify the switch of Koseki to include manual/auto switches of Satoh in order to continue perform an operation automatically even when an operator's hand is removed from the switch and the switch is returned to the neutral position N. The modifications thus reduce switching time and quickly release operator's hand in auto switching operation".

Applicant notes that while the Examiner has described the switching operation in the Satoh, et al. patent, the Examiner has failed to point out that, as shown in FIG. 22 of the patent and described in the corresponding description in the patent, the switches of the patent are switches for a power window in an automobile. Thus, the patent teaches that when the knob Kb is moved to a position ATup or ATdown and then released from an operator's hand, the knob Kb returns to the neutral position N while a window motor rotates continuously so that a window is opened or closed to its full extent correspondingly to the operation position (ATup or ATdown) and thereafter electricity to the window motor is turned off

The Satoh, et al. patent thus deals with a power window for an automobile, while the Koseki, et al. patent deals with a digital camera and the synthesizing of images in the camera. Thus, the patents deal with totally unrelated fields of endeavor, and the fact that both patents use switches is insufficient to conclude that a skilled person dealing with the cameras of the Koseki, et al. patent would be motivated to modify such cameras by looking to the teachings of the totally unrelated Satoh, et al. patent in the field of automobile technology.

The Examiner's requirement in assessing patentability is to provide a reasoned analysis of the art leading to the Examiner's conclusions. Here there is no reasoned analysis of where the motivation comes from for the Examiner's modification of the Koseki, et al. camera or that there were problems with the camera in the Koseki, et al. patent which would have necessitated modification of the switches used therein.

Applicant thus submits that the combination of the Koseki, et al. and Satoh, et al. patents is improper and, therefore, that the rejection based thereon should be withdrawn. Applicant further submits that, even assuming arguendo that the combination could be made, the resultant structure would still not include the other features previously discussed above as patentably distinguishing applicant's claims over the Koseki, et al. patent.

Additionally, neither the Koseki, et al. patent nor Satoh, et al. patent alone, or in combination, teaches the above discussed features of applicant's amended claims 1 and 11 in further combination with a second operation member different from said first operation member and a control unit which makes said image pickup apparatus shift from the active state to the non-active state if said second operation member is operated when said image pickup apparatus is in the active state and said first operation member is positioned at the third position. Thus applicant's independent claims 1, 8, 11 and 12, and their respective claims,

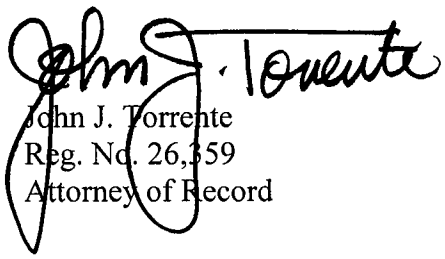
patentably distinguish over the Koseki, et al., and Satoh, et al. patents.

The Ejima, et al. reference merely teaches the use of an operation button in different modes. Thus, the Ejima, et al reference fails to add anything to the Koseki, et al. and Satoh, et al. patents to result in applicant's invention of amended independent claims 1, 8, 11 and 12, and their respective dependent claims.

In view of the above, it is submitted that applicant's claims, as amended, patentably distinguish over the cited art of record. Accordingly, reconsideration of the claims is respectfully requested.

Dated: November 19, 2009

Respectfully submitted,



COWAN, LIEBOWITZ & LATMAN, P.C.
1133 Avenue of the Americas
New York, New York 10036-6799
T: (212) 790-9273

John J. Torrente
Reg. No. 26,359
Attorney of Record